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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/927,368

08/13/2001

Hisaya Mori

50090-332

4507

7590

02/23/2004

McDERMOTT, WILL & EMERY
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EXAMINER

HOLLINGTON, JERMELE M

ART UNIT

PAPER NUMBER

2829

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,368

Applicant(s)

MORI ET AL.

Examiner

Jermele M. Hollington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1103. 6) ☐ Other:

DETAILED ACTION

- 1) Note to the applicants, a different examiner is examining this application from now until the application becomes allow or abandon.
- 2) Claims 1-5 and 7-12 remain for examination.
- 3) The rejection under 35 U.S.C. 103(a) as being unpatentable over Toshishige (01-316024) in view of Rosenthal et al ('521) for claims 1-5, 7 and 10-12 and Toshishige (01-316024) in view of Rosenthal et al ('521) and further in view of Coggins et al ('365) is withdrawn.
- 4) A new ground of rejection is given as follows.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
2. Claims 1-5 and 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 7, the limitation states: "...digital test data produced by converting analog test data output from the digital-to-analog converter circuit into a digital signal..." It is not clear from the claim on how the converting analog test data output from the digital-to-analog converter circuit into a digital signal. It is well known in the art that digital-to-analog converter circuit outputs analog signals only. Even if there are means for producing the output as claimed, the applicants have not described those means within the claim language.

For examination purposes, the examiner is taking the position that instead of digital test data being produced that analog test data is being produced from an analog signal.

Further claims 1 and 7 states: "...wherein the data memory is divided into two memory sections such that, when digital test data is stored in one memory section, digital test data previously stored in the other memory section is loaded for analysis purpose." It is not clear from the claim how the memory sections are used for analysis purpose. It is not clear from the claim how the applicants determined which section to use and if there could be a switch means to choose which section to use for analysis purpose.

For examination purposes, the examiner is taking the position that the data memory has only one section for analysis purpose until the applicants have given an explanation or modify the claim to explain the memory sections.

Since claims 2-5 depend off of claim 1, they are also rejected for the above reason.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of U.S. Patent No. 6,642,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because although claim 1 of U.S. Patent 6,642,736 does not state that the data memory having two memory sections, it would be obvious of having two section since the test device is testing both D/A converter circuit and A/D converter where, as claimed in claim 1, "...data memory to store the digital test outputs... and... an analyzer portion to analyze each of said digital test outputs stored in said measure data memory..."

Conclusion

5. Applicant's arguments with respect to claims 1-5 and 7-12 have been considered but are moot in view of the new ground(s) of rejection.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saitoh et al (5436558), Currin et al (5999008), Hashimoto (6255842), Mori et al (6628137 and 6661248) disclose a method and apparatus for testing semiconductor integrated circuit.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermele M. Hollington whose telephone number is (571) 272-1960. The examiner can normally be reached on M-F (9:00-4:30 EST) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (517) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1651.

Jermele M. Hollington
Examiner
Art Unit 2829

J. M. H.
JMH

January 29, 2004

Mark T. Ray
02/02/04